

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SEDN/12163	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 09/973,081	Filed 10/10/2001
First Named Inventor William D. Swart		Examiner Dominic D. Salterelli	
Art Unit 2421		Examiner Dominic D. Salterelli	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. **39,414**
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Eamon J. Wall

Typed or printed name

732-842-8110 X120

Telephone number

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
William D. Swart, et al.	§	
	§	Group Art Unit: 2421
Serial No.: 09/973,081	§	
	§	
Confirmation No.: 5256	§	
	§	Examiner: Saltarelli, Dominic, D.
	§	
Filed: October 10, 2001	§	
	§	
For: VIDEO AND DIGITAL MULTIMEDIA	§	
ACQUISITION AND DELIVERY SYSTEM	§	

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In conjunction with the Notice of Appeal and the Pre-Appeal Brief Request for Review (form PTO/SB/33) filed herewith, the Applicants request a Panel review of the Final Rejection in this matter for the reasons stated below. The Applicants believe that a one month extension of time fee **(\$130)** and a notice of appeal fee **(\$540)** is due in connection with this response. The Commissioner is hereby authorized to charge counsel's credit card account.

Furthermore, in the event that the Commissioner is unable to obtain the necessary fees from Applicants' credit card account, the Commissioner is hereby authorized to charge counsel's Deposit Account No. 50-4802/SEDN/12163 for the one month extension of time fee, notice of appeal fee and any additional fees, excess claim fees, required to make this response timely and acceptable to the Office.

ARGUMENTS IN SUPPORT OF THE PRE-APPEAL REQUEST FOR REVIEW

Applicants respectfully submit that the rejections of record are based on clear factual deficiencies in the applied references. Accordingly, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established.

The Claimed Invention

The claimed invention generally relates to the acquisition and delivery of content. Pending independent claim 11 is described below:

Claim 11 relates to a method for acquiring and delivering content, comprising:

- receiving a content search request from a user terminal;
- providing a plurality of content associated with said content search request to a user via a numeric television channel selectable by a user;
- receiving a content download request from said user terminal, wherein a content of said content download request is one of said plurality of content found in response to said content search request;
- determining if the request is a local download request or a remote download request;
- if the request is a remote download request, determining if the content is to be delivered directly or indirectly, wherein directly delivering content comprises providing the content to the user terminal without traversing any modules between a remote content server and the user terminal, thereby bypassing an aggregator; and
- if the content is to be delivered directly:
 - establishing a communications link from the remote content server to the user terminal, thereby bypassing an aggregator,
 - forwarding the requested content toward the user terminal via said television channel,
 - validating the delivery of the content to the user terminal, and

logging the validated delivery in one of a local server database and a remote server database.

Rejections Under 35 U.S.C. § 103

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks et al. (U.S. pat. no. 5,600,573) ("Hendricks") in view of Kenner et al. (U.S. pat. no. 5,956,716) ("Kenner"), Campanella (U.S. pat. no. 5,864,546) ("Campanella"), Farry et al. (U.S. pat. no. 5,608,447) ("Farry"), and Hoarty (U.S. pat. no. 5,485,197) ("Hoarty"). Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks, Kenner, Campanella, Farry, Hoarty, and further in view of Wilkins (U.S. pat. no. 5,446,919) ("Wilkins"). These rejections are traversed below.

At pages 5-7 of Applicants' "Response Under 37 C.F.R. 1.116" filed January 20, 2009, Applicants discussed how a combination of Campanella, Farry, and Hoarty is improper in rejecting claim 11, given MPEP § 2141.02(VI) and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied 469 U.S. 851 (1984) (requiring that a prior art references must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention; also providing that it is impermissible to use the claims as a framework from which to choose among individual references to recreate the claimed invention). Applicants incorporate those remarks herein by way of reference.

In short, and as discussed therein, Campanella discloses a system that relies on frequency division multiple access (FDMA) techniques, whereas the Hoarty and Farry communications are based on time division multiplexing (TDM) techniques. Campanella's FDMA techniques are inoperable with the TDM techniques of Hoarty and Farry. As such, one skilled in the art, when reading each of the references as a whole, would not have had an apparent reason to combine the references in the manner indicated at pages 5-7 of the Final Office Action mailed November 17, 2008.

At page 2 of the Advisory Action mailed January 28, 2009, the Office suggests that Applicants' remarks do not address the issue of whether the proposed combination of references would be obvious. More specifically, the Office contends that the prior art

invention (e.g., the primary reference) being modified is Hendricks, that Hendricks is modified in view of Campanella, and that the specifics of Campanella's distribution system do not affect the obviousness of further modifying Hendricks in view of other prior art after being modified in view of Campanella.

As a preliminary matter, Applicants note that it is the Office that bears the initial burden of demonstrating any *prima facie* conclusion of obviousness, and that if the Office fails to produce a *prima facie* case, Applicants are under no obligation to submit evidence of nonobviousness. See MPEP § 2142.

Moreover, Applicants respectfully disagree with the Office's contentions, and submit that the Office has used impermissible hindsight in combining the references. Indeed, the Office has selectively read those portions of the secondary references that are most favorable to formulating a rejection, and in doing so, has failed to consider those references as a whole. Applicants submit that such a practice is improper under the provisions/holdings of MPEP § 2141.02(VI) and *W.L. Gore & Associates* cited above. Accordingly, Applicants submit that a section 103 rejection of claim 11 is improper for at least the foregoing reasons.

Notwithstanding whether any other combination of the applied references is proper, no other such combination would have resulted in all of the features recited in claim 11. Accordingly, claim 11 is allowable.


Claims 12 and 13 depend from claim 11, and are allowable for at least the same reasons as claim 11 because Wilkins fails to remedy the deficiencies described above (notwithstanding whether Wilkins is properly combinable with any of the other applied references).

CONCLUSION

For at least the above reasons, the rejections of pending claims 11-13 in the Final Office Action is improper, because a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established. A pre-appeal finding that these claims are allowable is respectfully requested.

Respectfully submitted,

Dated: 2/20/09



Eamon J. Wall
Registration No. 39,414
Attorney for Applicant(s)

WALL & TONG, LLP
595 Shrewsbury Avenue
Shrewsbury, New Jersey 07702
Telephone: 732-842-8110
Facsimile: 732-842-8388